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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,997	08/29/2001	Qinwei Shi	1112-1-052CON	9957

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EXAMINER

HINES, JANA A

ART UNIT PAPER NUMBER

1645

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/941,997

Applicant(s)

SHI ET AL.

Examiner

Ja-Na Hines

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1,3,9 and 16.
Claim(s) withdrawn from consideration: 4-8 and 10-15.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____


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The proposed amendments filed after a final rejection will not be entered because the amendment raises new issues that would require further search and consideration. The proposed amendments change the claims from being open and inclusive language to now reciting closed claim language. Furthermore, the new issues are drawn to a claim that recites a fragment having about 95 to 115 amino acids, wherein the fragment is SEQ ID NO:2. However SEQ ID NO:2 has 99 amino acids; thus the new issues include defining what the other about 16 amino acids and which about 4 amino acids from SEQ ID NO:2 can be deleted. Furthermore, further consideration would be drawn to determining the difference between newly amended claims 1 and 3. Therefore because the proposed amendment does not place the application in better form for appeal by materially reducing or simplifying the issues, the amendment will not be entered.

The rejection of claims 1 and 9 under 35 U.S.C. 112, second paragraph, is maintained for reasons already of record.

It is noted that the after final amendment of claim 9 still fails to address the issue that the claim is indefinite. Applicants appear to assert that the reference sequence is clear. However the examiner urges that the claims are still indefinite. Different teachings teach that human cardiac troponin I has 209, 210 or 226 amino acids. Therefore the claims are still unclear and indefinite because the claims fail to recite the reference sequence upon which the recited amino acids are based upon. Therefore, the claims are indefinite and appropriate clarification is required to overcome the rejection.

The rejection of claims 1, 3 and 9 under 35 U.S.C. 102(b) as being anticipated by Morjana et al., (WO97/19955) is maintained for reasons already of record.

The rejection of claims 1 and 9 under 35 U.S.C. 102(b) as being anticipated by Moses et al., (WO 97/30085) is maintained for reasons already of record.

The rejection of claims 1, 3 and 16 under 35 U.S.C. 102(e) as being anticipated by Potter et al., (WO97/39132) is maintained for reasons already of record.

All of the rejections are interpreted to be inclusive or open-ended and do not exclude additional, unrecited elements or method steps. The difference between the prior art references and the instant claims is that the references teach additional amino acids, however since the claims are interpreted as allowing the inclusion of other amino acids in addition to those recited, the prior art references meet the limitation of the claims. Therefore, applicants' arguments are not persuasive and the rejections are maintained.

The new matter rejection of claim 9 under 35 U.S.C. 112, first paragraph, is maintained for reasons already of record. It appears that there is no support in the specification. Thus, applicants must specifically point to page and line number support for the identity of an isolated polypeptide consisting essentially of a fragment of human cardiac troponin I wherein the N-terminus of the fragment is about amino 20 to about 30 and the C-terminus of the fragment is about amino acid 95 to about 115 of native human cardiac troponin I as recited by the claim amendment. Therefore, the claim incorporates new matter and the rejection is maintained.

The rejection of claim 16 under 35 U.S.C. 112, second paragraph, as being indefinite is maintained. Applicants appear to have amended claim 16. The text of all claims being currently amended must be presented with marking. All of the added text must be shown by underlining. Applicant has failed to follow the appropriate amendment practice procedure with respect to claim 16.